

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 09/376811

Filing Date: August 18, 1999

Title: COMPUTERIZED INCENTIVE SYSTEM

Page 6

Dkt: 494.004US1

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on November 8, 2002, and the references cited therewith.

Claims 1, 6, 10, 11, 12, 13, and 24 are amended and claims 5 and 26-40 are canceled; as a result, claims 1-4 and 6-25 are now pending in this application. Claim 6 has been amended to provide proper claim dependency. Claims 10-13 have been amended to correct minor typographical errors; claims 1 and 24 have been amended to clarify what applicant considers the invention.

Affirmation of Election

As provisionally elected on July 3, 2002, Applicant elects to prosecute the invention of Group I, claims 1-25.

The claims of the non-elected invention, claims 26-40, are hereby canceled. However, Applicant reserves the right to later file continuation or divisional applications having claims directed to the non-elected inventions.

§101 Rejection of the Claims

Claims 1-25 were rejected under 35 USC § 101 as being directed to non-statutory subject matter. Applicant respectfully traverses this rejection. According to the M.P.E.P. § 2106, subject matter within the ambit of 35 U.S.C. § 101 includes computer-related processes limited to a practical application in the technological arts. "A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T*, 172 F.3d at 1358, 50 USPQ2d at 1452." (M.P.E.P. §2106 at p. 2100-18). Applicant has amended claim 1 in the manner suggested by the Office Action (i.e., Applicant has added "in a computer" as a limitation of claim 1). Because claim 1 is in condition for allowance, claims depending from claim 1 are also in condition for allowance. Therefore, Applicant requests that this rejection be withdrawn.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

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Title: COMPUTERIZED INCENTIVE SYSTEM

Page 7

Dkt: 494,004US1

§112 Rejection of the Claims

Claims 5, 6, 24 and 25 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In reference to claim 5, claim 5 has been canceled. In reference to claim 24, the Office Action indicated that limitations relating to the term "heuristically" were unclear. Claim 24 has been amended to overcome this rejection.

While the Office Action has not noted specific reasons for rejecting claims 6 and 25 under §112, these claims have been amended and Applicant believes they are in condition for allowance.

102 Rejection of the Claims

Claims 1-6, 10, 14-19 and 21-25 were rejected under 35 USC §102(b) as being anticipated by Ho et al. (US 6,120,300). Applicant respectfully submits that Ho et al. (hereinafter referred to as Ho) does not qualify as prior art under 35 USC §102(b). Ho cannot qualify as prior art under 35 USC §102(b) because Ho issued after Applicant filed the present application. Additionally, Applicant reserves the right to swear behind any of the cited references.

As noted above, Ho cannot qualify as prior or under 35 USC§102(b). However, even if Ho were prior art, it would not anticipate the claimed invention, as set forth in amended independent claim 1. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

Claim 1 recites "including at least one minimum threshold level of performance." Additionally, claim 1 recites the "predetermined goal data further comprising an identification of one of the at least one minimum threshold level of performance as a desired level of performance." Ho discloses a computer-aided educational system for rewarding a student when the student attains a milestone in a subject. The Office Action does not point to passages in Ho disclosing the above cited claim limitations and Applicant knows of no such passages. Thus, for at least these reasons, Ho does not anticipate claim 1. Applicant respectfully submits that

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

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Title: COMPUTERIZED INCENTIVE SYSTEM

Page 8

Dkt: 494.004US1

dependant claims 2-4, 6, 10, 14-19 and 21-25, which depend from claim 1, are not anticipated for the same reasons. Applicant respectfully requests that the rejection of these claims under 35 U.S.C. § 102(b) be withdrawn.

103 Rejection of the Claims

Claims 1-25 were rejected under 35 USC 103(a) as being unpatentable over Ho et al. in view of Noori et al. ("Production and Operations Management, Total Quality and Responsiveness", McGraw-Hill, Inc.).

As explained above, Ho does not teach "goal data including at least one minimum threshold level of performance." Ho also does not teach "predetermined goal data further comprising an identification of one of the at least one minimum threshold level of performance as a desired level of performance." Therefore, the only way the cited combination can render independent claim 1 obvious is for Noori et al. (hereinafter referred to as Noori) to teach or suggest what Ho is lacking. The Office Action indicates that Noori teaches providing a reward system for encouraging employees to act in a manner consistent with a firm's goals and objectives and to attract and keep high-quality employees. As such, Noori does not teach or suggest the limitations of claim 1 that Ho fails to teach. Therefore, the cited combination cannot render obvious Applicant's invention as recited in independent claim 1. For the same reasons, Applicant respectfully submits that the cited combination cannot render obvious Applicant's invention as claimed in dependent claims 2-4 and 6-25, which depend from claim 1. Applicant respectfully requests the withdrawal of the rejection of these claims under 35 U.S.C. § 103(a) over the combination.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 09/376811
Filing Date: August 18, 1999
Title: COMPUTERIZED INCENTIVE SYSTEM

Page 9
Dkt 494.004US1

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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The undersigned hereby certifies that this correspondence is being transmitted by facsimile (FAX NO. 703-305-7687) to: Commissioner of Patents, Attn: Examiner Elaine L. Gort, GAU 3627, Washington, D.C. 20231, on this 8th day of April, 2003.

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